

AMENDMENT UNDER 37 C.F.R. § 1.116

U.S. Application No.: 09/863,476

Attorney Docket No.: Q646483

REMARKS

Claims 1-13 and 15-18 remain pending in the application. The subject matter of Claims 1 and 16-17 have been objected to under 35 U.S.C. § 132 as introducing new matter in the application. Applicant hereinabove amends claim 1 to obviate the objection.

Claims 1-5, 10 and 16-17 have been rejected under 35 U.S.C. § 102 as being anticipated over Ohtsuka (U.S.P. 6,788,425) or alternatively has been rejected under 35 U.S.C. § 103 as being obvious over Ohtsuka. Claims 6-9, 11-13 and 15 have been rejected under 35 U.S.C. § 103 as being unpatentable over Ohtsuka in view of Sparks (U.S.P. 6,167,382). Claims 1-13 and 15 have been rejected under 35 U.S.C. § 103 as being obvious in view of Tamura (6,771,896). Claim 15 has been rejected under 35 U.S.C. § 103 as being unpatentable over Tamura in view of Cone or Narayanaswamy. All references are previously of record. Applicant respectfully submits the following arguments in traversal of the prior art rejections.

With regard to the rejections over Ohtsuka, the Examiner has provided alternative rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103. With regard to the Section 103 obviousness rejection, Applicant submits that the cited U.S. Patent reference was not issued until September 7, 2004 and thus qualifies as prior art only under 35 U.S.C. § 102(e). Under 35 U.S.C. § 103(c), Ohtsuka may be removed by demonstrating a common obligation of assignment. In this regard, Applicant directs the Examiner's attention to the assignment of the present application recorded on May 24, 2001 to Fuji Photo Film Co., Ltd (Reel 011848, Frame 0865) and the assignment of Ohtsuka on April 24, 1998 to the same assignee (Reel 00913, Frame

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0513). Accordingly, Applicant submits that the Section 103 rejection over Ohtsuka should be withdrawn.

With regard to the anticipation rejection of independent claim 10 under 35 U.S.C. § 102, the Examiner contends that the description of thumbnail images prepared on the basis of high-precision image data receives no patentable weight. The Examiner alleges that the description merely describes how the image is made and suggests that this does not affect structural features of the images. However, this is incorrect since the precision of the data will necessarily impact the quality (such as resolution, clarity or other observable effect) of the image. Therefore, the terminology should be given due consideration. Alternatively, the Examiner contends that the feature of high precision data is inherent. This is incorrect since Ohtsuka is not particularly concerned with the quality of any produced vouchers. The Examiner's contention that the apparatus of the present invention and that of Ohtsuka is the same, or would suggest the same result as the present invention, is also not supportable.

Further, in the alternative, the Examiner contends that it would be obvious to modify Ohtsuka to provide the high precision data for the thumbnail image formation. However, due to a common obligation of assignment as discussed above, such an obviousness rejection is not supportable. Therefore, claim 10 is patentable for at least this reason. Claims 6 and 11 are patentable for analogous reasons. Claims 7-9, 12-13, and 15 are patentable based on their dependency.

With regard to the anticipation rejection of independent claim 1, this claims describes that the thumbnail image is based on high precision data. The Examiner contends that Fig. 2 of

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Ohtsuka inherently teaches this aspect of the thumbnail image formation. However, Applicant submits that Fig. 2 relates to print order information sent to a printer 20. See Col. 5, lines 25-28. There is no requirement that any thumbnail images be printed in accordance with high resolution data in Ohtsuka. The Examiner's alternative rejection of claim 1 under Section 103 is not supportable in view of the common obligation of assignment. Claims 2-5 and 16-18 are patentable based on their dependency.

With regard to the additional rejection of claims 6-9, 11-13 and 15 over Ohtsuka in view of Sparks, Applicant submits that the common obligation of assignment of Ohtsuka and the present application renders the rejection improper. The Examiner's discussion about the obvious effects in Ohtsuka are also not supportable.

With regard to the additional rejection of claims 1-13 and 15 as being unpatentable over Tamura, Applicant submits the following arguments.

With regard to claims 1 and 10, these claims recite separately an image printer and a voucher printer which prints a thumbnail. The Examiner cites multiple different embodiments of Tamura to teach these two aspects of the claims. Fig. 4 relied upon by the Examiner relates to a photofinisher printing device, which the Examiner correctly concedes does not teach a thumbnail printer. Figs. 12 and 13(a)-(b) of Tamura relate to a home printing arrangement. In the home arrangement, the printer 130 prints both images and any purported printing information associated therewith. Applicant submits that no single embodiment of Tamura includes both an image printer and a thumbnail voucher printer, and it is impermissible for the Examiner to combine features of different embodiments without a basis to do so. *Ex parte Beuther*, 71

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USPQ2d 1313, 1316 (BPAI 2003). Therefore, claims 1 and 10 are patentable for at least these reasons. Claims 2-5 and 16-18 are patentable based on their dependency.

With further regard to independent claims 6 and 10-11, the Examiner has disregarded the recitation of thumbnails formed from high precision data. This recitation must be properly accounted for since the data would affect the structural aspects of the formed thumbnail. The Examiner's assumption about the high precision data with regard to Tamura is not supportable for the same reasons set forth above for Ohtsuka. Therefore, claims 6 and 10-11 are patentable for this additional reason.

With further regard to independent claims 6 and 11, these claims describe transmission of order and thumbnail information (e.g. via email) back to the person who placed an order. The Examiner again mixes unrelated teachings from different disclosed embodiments, which is impermissible given the Board Decision in *Ex parte Beuther*. Moreover, to the extent the cited col. 13 of Tamura describes communications of order status information, the communication does not include any thumbnail information. The Examiner's reliance on col. 20 of Tamura also does not render claims 6 and 11 obvious since there is no teaching of a transmission of thumbnail information back to the ordering entity. Therefore, claims 6 and 11 are patentable for at least these reasons.

Applicant submits that the remaining claims 7-9 and 12-15 are patentable based on their dependency, as none of the additional references of Cone or Narayanaswamy make up for the deficiencies of the primary references Ohtsuka and Tamura or the combination of Tamura and Sparks.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

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